

REMARKS

This Office Action Response is submitted in response to the outstanding Office Action, dated June 5, 2008. Claims 1-3, 17-19, 23-25 and 29 are presently pending in the above-identified patent application. Claims 1 and 23 are herein proposed to be amended. Support for
5 the amendments can be found, for example, on page 7, lines 3-17, page 8, line 15 through page 9, line 23, and page 10, lines 8-12. No new matter is being introduced.

In the outstanding Office Action, the Examiner rejected claims 1-3, 23-25 and 29 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject
matter.

10 The comments of the Examiner in forming the objection and rejections are acknowledged and have been carefully considered.

FORMAL REJECTIONS

As mentioned above, the Examiner rejected claims 1-3, 23-25 and 29 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. On page 4 of the Office Action, the Examiner states that

the method claims are not so tied to another statutory class of invention because the method steps that are critical to the invention are “not tied to any particular apparatus or machine” and therefore do not meet the machine-or-transformation test as set forth in *In re Bilski* 545 F.3d 943, 88 USPQ2d 1385 (Federal Circuit, 2008).

Applicant, as proposed herein, has amended independent claim 1 to include a computer-implemented method for characterizing gene expression, wherein the method is run on a system comprising one or more distinct devices, each of the one or more distinct devices being embodied on a tangible computer-readable recordable storage medium executing on a hardware processor to perform the denoted steps. Support for the amendments can be found, for example, on page 7, lines 3-17 and page 8, line 15 through page 9, line 23.

As stated by the United States Court of Appeals for the Federal Circuit (*In re Bilski* (2008)), “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” As such, Applicant respectfully asserts that, as amended, independent claim 1 recites a tie to a particular machine or apparatus, namely, a data storage device executing on a processor.

Further, Applicants respectfully submit that the ties to the device that execute on a hardware processor, as well as the tie to an apparatus such as a computer, overcome the rejection and provide patentable subject matter. In *Ex parte Bo Li*, Appeal 2008-1213 (BPAI 2008), the BPAI stated that

the instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994).

Therefore, Applicants respectfully assert that independent claim 1, as amended,

overcomes the §101 rejection. Also, Applicant further submits that by virtue of their dependence on allowable independent claim 1, claims 2-3 and 29, respectively, are directed to statutory subject matter in their own right.

Also, on page 4 of the Office Action, the Examiner states that

claims 23-25 recite “an article of manufacture comprising a computer readable medium.” The computer-readable medium of the [] claims reads on carrier waves, which read on transitory propagating signals which are not proper patentable subject matter....

Applicants, as proposed herein, has amended independent claim 23 to include a tangible computer readable recordable storage medium having computer readable code means embodied thereon. Support for the amendment can be found, for example, on page 10, lines 8-12 of the specification. As such, Applicants respectfully submit that claim 23 and the claims dependent therefrom are directed to patentable subject matter.

Given the above remarks, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-3, 23-25 and 29 under 35 U.S.C. §101.

In view of the foregoing, Applicants submit that the pending claims, i.e., claims 1-3, 17-19, 23-25 and 29, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner’s attention to this matter is appreciated.

Respectfully submitted,



Michael J. Cooper
Attorney for Applicant(s)
Reg. No. 57,749
Ryan, Mason & Lewis, LLP
1300 Post Road, Suite 205
Fairfield, CT 06824
(203) 255-6560

Date: May 26, 2009